

PATENT COOPERATION TREATY

From the
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

To: JOHN K. HARROP
DORSEY & WHITNEY LLP
1001 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, D.C. 20004

PCT

WRITTEN OPINION

(PCT Rule 66)

Applicant's or agent's file reference 5267.01		Date of Mailing (day/month/year) 13 AUG 2001
International application No. PCT/US00/09541		REPLY DUE within TWO months from the above date of mailing
International filing date (day/month/year) 11 APRIL 2000	Priority date (day/month/year) 13 APRIL 1999	
International Patent Classification (IPC) or both national classification and IPC IPC(7): H04N 7/173 and US CL.: 725/87		
Applicant DISCOVERY COMMUNICATIONS INC.		

1. This written opinion is the first (first, etc.) drawn by this International Preliminary Examining Authority.
2. This opinion contains indications relating to the following items:
 - I ☒ Basis of the opinion
 - II ☐ Priority
 - III ☐ Non-establishment of opinion with regard to novelty, inventive step or industrial applicability
 - IV ☐ Lack of unity of invention
 - V ☒ Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
 - VI ☒ Certain documents cited
 - VII ☐ Certain defects in the international application
 - VIII ☐ Certain observations on the international application
3. The applicant is hereby invited to reply to this opinion.

When? See the time limit indicated above. ~~The applicant may, before the expiration of that time limit, request this Authority to grant an extension, see Rule 66.2(d).~~

How? By submitting a written reply, accompanied, where appropriate, by amendments, according to Rule 66.3. For the form and the language of the amendments, see Rules 66.8 and 66.9.

Also For an additional opportunity to submit amendments, see Rule 66.4.
For the examiner's obligation to consider amendments and/or arguments, see Rule 66.4 bis.
For an informal communication with the examiner, see Rule 66.6.

If no reply is filed, the international preliminary examination report will be established on the basis of this opinion.
4. The final date by which the international preliminary examination report must be established according to Rule 69.2 is: **13 AUGUST 2001**

Name and mailing address of the IPEA/US Commissioner of Patents and Trademarks Box PCT Washington, D.C. 20231 Facsimile No. (703) 305-3230	Authorized officer CHRISTOPHER GRANT Telephone No. (703) 305-4755
--	--

DOCKETED

8-17-01

Wk

WRITTEN OPINION

International application No.

PCT/US00/09541

I. Basis of the opinion

1. With regard to the elements of the international application:*

☒ the international application as originally filed

☒ the description:

pages 1-74, as originally filed
pages NONE, filed with the demand
pages NONE, filed with the letter of

☒ the claims:

pages 75-96, as originally filed
pages NONE, as amended (together with any statement) under Article 19
pages NONE, filed with the demand
pages NONE, filed with the letter of

☒ the drawings:

pages 1-53, as originally filed
pages NONE, filed with the demand
pages NONE, filed with the letter of

☒ the sequence listing part of the description:

pages NONE, as originally filed
pages NONE, filed with the demand
pages NONE, filed with the letter of

2. With regard to the language, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language which is:

- ☐ the language of a translation furnished for the purposes of international search (under Rule 23.1(b)).
- ☐ the language of publication of the international application (under Rule 48.3(b)).
- ☐ the language of the translation furnished for the purposes of international preliminary examination (under Rules 55.2 and/or 55.3).

3. With regard to any nucleotide and/or amino acid sequence disclosed in the international application, the written opinion was drawn on the basis of the sequence listing:

- ☐ contained in the international application in printed form.
- ☐ filed together with the international application in computer readable form.
- ☐ furnished subsequently to this Authority in written form.
- ☐ furnished subsequently to this Authority in computer readable form.
- ☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
- ☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. ☒ The amendments have resulted in the cancellation of:

- ☒ the description, pages NONE
- ☒ the claims, Nos. NONE
- ☒ the drawings, sheets/fig. NONE

5. ☐ This opinion has been drawn as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).

* Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this opinion as "originally filed".

WRITTEN OPINION

International application No.

PCT/US00/09541

V. Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. statement

Novelty (N)	Claims (Please See supplemental sheet)	YES
	Claims (Please See supplemental sheet)	NO
Inventive Step (IS)	Claims (Please See supplemental sheet)	YES
	Claims (Please See supplemental sheet)	NO
Industrial Applicability (IA)	Claims (Please See supplemental sheet)	YES
	Claims (Please See supplemental sheet)	NO

2. citations and explanations

Claims 1-49, 51-67, 70-97, 100-178, 180, 182-184, 186-207, 211-212 and 216-220 lack novelty under PCT Article 33(2) as being anticipated by Hendricks (WO 95 15649).

Considering claim 1, Hendricks discloses an apparatus that provides electronic book to a subscriber, comprising:

- a) a processor (located at 278) that communicates with an electronic book ordering site (282);
- b) a transmitter (located at 278);
- c) a receiver module (262); and
- f) a memory (600).

Claim 2 is met by the viewer disclosed throughout the reference including but not limited to figures 6a and 11.

Claims 3-14 are met by the library unit disclosed throughout the reference including but not limited to figures 6a and 8.

Claims 15-49 and 51-58 are met by figures 1-18.

Considering claim 59, Hendricks discloses a system for distributing an electronic book from a remote site to an apparatus capable of viewing the electronic book comprising:

- a) an electronic book distribution point (250);
- b) a network (208) coupled to the distribution point;
- c) an electronic book device coupled to the network, the electronic book comprising:
- d) an electronic book viewer (266);
- e) home subsystem (258);
- f) an interface (212); and
- g) a memory (262).

Claims 60-67 and 70-92 are met by figures 2-6.

Considering claim 93, Hendricks discloses an apparatus that provides electronic book ordering and distribution comprising:

- a) a terminal that displays electronic books and generates (Continued on Supplemental Sheet.)

WRITTEN OPINION

International application No.

PCT/US00/09541

VL Certain documents cited

1. Certain published documents (Rule 70.10)

<u>Application No. Patent No.</u>	<u>Publication Date (day/month/year)</u>	<u>Filing Date (day/month/year)</u>	<u>Priority date (valid claim) (day/month/year)</u>
US 6,052,717 A	18 APRIL 2000	23 OCTOBER 1996	NONE
US 6,034,680 A	07 MARCH 2000	30 APRIL 1997	25 APRIL 1997

2. Non-written disclosures (Rule 70.9)

Kind of non-written disclosureDate of non-written disclosure
(day/month/year)Date of written disclosure
referring to non-written disclosure
(day/month/year)

Supplemental Box

(To be used when the space in any of the preceding boxes is not sufficient)

Continuation of: Boxes I - VIII

Sheet 10

TIME LIMIT:

The time limit set for response to a Written Opinion may not be extended. 37 CFR 1.484(d). Any response received after the expiration of the time limit set in the Written Opinion will not be considered in preparing the International Preliminary Examination Report.

V. 1. REASONED STATEMENTS:

The opinion as to Novelty was positive (YES) with respect to claims 50, 68, 69, 98, 99, 179, 181, 185, 208-210, 213-215.

The opinion as to Novelty was negative (NO) with respect to claims 1-49, 51-67, 70-97, 100-178, 180, 182-184, 186-207, 211-212, 216-220.

The opinion as to Inventive Step was positive (YES) with respect to claims NONE.

The opinion as to Inventive Step was negative (NO) with respect to claims 1-220.

The opinion as to Industrial Applicability was positive (YES) with respect to claims 1-220.

The opinion as to Industrial Applicability was negative (NO) with respect to claims NONE.

V. 2. REASONED STATEMENTS - CITATIONS AND EXPLANATIONS (Continued):

electronic book orders (266, figure 6a);

b) an order and authorization system (330, figure 3); and

c) a broadcaster (358, figure 3).

Claims 94-97 and 100-105 are met by figures 14A-14J.

Claims 106-107 and 116 are met by billing and collection system (278) (figure 2).

Claims 108-115 and 117-118 are met by the systems in figures 1-6.

Considering claim 119, Hendricks discloses a system that provides broadcast electronic book ordering and delivery, comprising:

a) a terminal (266, figure 6a or 266 figure 18a);

b) a processor (330-334, figure 3 or 1024, figure 18a); and

c) a delivery system (358, figure 3 or modulators 18a).

Claims 120-133 are met by figures 14Aa-14J.

Claims 134-178, 180, 182-184, 186-207, 211-212 and 216 are met by figures 1-18.

Considering claim 217, Hendricks discloses a system for delivering electronic books, comprising:

a) a plurality of machines, a machine comprising:

b) a microprocessor (628); and

c) a transceiver (604);

d) a memory (600);

e) a network (coaxial network or telephone network);

f) an interface (212, 270); and

g) an electronic book viewer (figure 11).

Claims 218-220 are met by figures 1-18.

Claims 50, 68-69, 98-99, 179, 181, 185, 208-210 and 213-215 lack an inventive step under PCT Article 33(3) as being obvious over Hendricks.

Considering claims 50, 68-69, 98-99, 179, 181, 185 and 208-210, Hendricks discloses all the claimed subject matter above, except for the Internet Web site, the Intranet site, electronic guide provided over the Internet and one or more of number identification, user name, addresses and browser related services as recited in the claims.

It is notoriously well known in the art that the Internet is the most widely used source of information including guide

Supplemental Box

(To be used when the space in any of the preceding boxes is not sufficient)

Continuation of: Boxes I - VIII

Sheet 11

information and that an Intranet site is routinely used for sharing information within a company or organization. Note that the Internet and Intranet includes a client server system having number identification, user name, addresses and browser related services/options.

Therefore, it would have been obvious to one of ordinary skill in the art to modify Hendricks' system to include the Internet Web site, electronic guide provided over the Internet, an Intranet site and one or more of number identification, user name, addresses and browser related services because an Internet web site is the mostly widely used source of various information and an Intranet site is routinely used for sharing information within a company or organization. Furthermore interacting with the Internet/Intranet involves processing and/or manipulating number identification, user name, addresses and browser related servers/options.

Considering claims 213-215, Hendricks discloses all the claimed subject matter above, except for e-mails as recited in the claims.

It is notoriously well known in the art that e-mails are routinely used to electronically transfer information between users.

Therefore, it would have been obvious to one of ordinary skill in the art to modify Hendricks' system to include e-mails for the typical advantage of utilizing a commonly used communication technique for sending and receiving information.

----- NEW CITATIONS -----

US 5,742,680 A (WILSON) 21 April 1998, abstract, column 5, lines 5-40.

US 4,855,725 A (FERNANDEZ) 08 August 1989, abstract, figures 1-3.

WO 95 15649 A (HENDRICKS et al.) 08 June 1995, whole document